



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

15

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/702,558

11/07/2003

Tryggvi Emilsson

ADV08 795

9569

7590

09/21/2004

D. JOSEPH ENGLISH

Duane Morris LLP

Suite 700

1667 K Street, N.W.

Washington, DC 20006

EXAMINER

GUHARAY, KARABI

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/702,558

Applicant(s)

EMILSSON, TRYGGVI

Examiner

Karabi Guharay

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 42-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13,14,17,19-24,26-36 and 39-41 is/are rejected.
- 7) ☒ Claim(s) 15,16,18,25,37,38 and 48-51 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/24/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Applicant's election with traverse of Group II in the reply filed on 6/18/2004 is acknowledged. The traversal is on the ground(s) that Claims 1-5 & 7-12 are directed to methods and claims 6, 42-47 are generic to methods of coating metallic foil or strip by spraying or vapor deposition. This is not found persuasive because

First of all claim 1 is a device claim claiming a glass body, a metallic foil providing connection through a pinch seal with a method of protecting foil, which is basically product by process claim. Thus claims 1-5 & 7-12 are considered as device claim.

Second of all applicant contends that examiner 's assertion that the product *cannot* be made by another and materially different process is in error. In other words, applicant agrees that the claimed product can be made by another materially different method, which is presented in the restriction requirement, filed on 5/18/2004.

Thus, restriction is considered to be proper.

Claims 1-12 & 42-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 contains the trademark/trade name "MAST-UP". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe type of bath used, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14, 19-24, 26-36 & 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss (US 4749902), in view of Sekhar et al. (US 6455107).

Regarding claim 13 & 30, Weiss discloses a method of coating a metallic foil with a corrosion –protection film (lines 60 of column 1-line 36 of column 2), comprising the steps of adhering a silica colloid to at least a portion of a metallic foil (lines 19-28 of column 3) and heated the coated metal foil (lines 30-38 of column 3), and attaching an electrical lead (4) to the foil (Fig 1, lines 23-24 of column 3)

Art Unit: 2879

However, Weiss does not include the step of exposing the silica colloid adhering to the foil to a fusion temperature to effect fusion of silica particles to form a silica film on the foil.

However, Sekhar et al. disclose a method of making a corrosion resistance coating wherein colloidal slurry containing silica (lines 58-59 of column 3) is first adhered to the article to be coated and then exposing the silica colloid to a fusion temperature to effect fusion of silica particles to form a silica film on the foil (lines 12-22 of column 4). Sekhar et al. further disclose that this method is advantageous and cost effective over PVD, or CVD or sol-gel method for producing thick coating for oxidation prevention (lines 9-14 of column 2).

Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method disclosed by Sekhar et al. in the method of Weiss, since this is a cost effective method for coating the bodies where the coated body is used at high temperature (lines 19-21 of column 4).

Regarding claim 14, Sekhar et al. disclose that the portion of the article to be coated is dipped into the bath comprising colloidal silica (lines 47-49 of column 2).

Reason for combining art as in claim 13 applies.

Regarding claims 19, & 20, Sekhar et al. disclose that the colloidal silica further comprises an organic binder (lines 1-2 of column 4), such as polyimides (see lines 29-35 of column 6).

Regarding claims 21 & 26, Weiss discloses that the foil comprises molybdenum (line 20 of column 1).

Art Unit: 2879

Regarding claims 22-24, Sekhar et al. disclose that the temperature of the fusion is above 900 degree centigrade (lines 26-29 of column 4). Thus depending upon the substance of the slurry one of ordinary skill in the art would have found obvious to choose different temperature appropriate for fusion of that particular slurry material.

Regarding claim 27, Sekhar et al. disclose that the silica colloid is adhered by spray coating, rolling, brushing or misting (lines 46-48 of column 2).

Regarding claims 28 & 29, Sekhar et al. disclose that the colloid is exposed to plasma or laser (lines 3-6 of column 4).

Regarding claim 31, Weiss discloses a second electrical lead (8) attached to the other end of the foil (6).

Regarding claims 33 & 34, Weiss discloses that the electrical lead forms an electrode for a high intensity discharge lamp such as halogen lamp (lines 47-48 of column 2).

Regarding claims 35 & 36, Sekhar et al. disclose a method of exposing an article to a predetermined temperature for a predetermined time comprising the steps of providing a heat source elevating the temperature of the source to a predetermined value then and passing the article for fusion of silica particles through the heat source at a rate to effect the exposure at a predetermined temperature for a predetermined time (lines 3-10 of column 4). Same reason for combining art as in claim 13 applies.

Regarding claim 39, Sekhar et al. disclose that the exposure is conducted in an inert atmosphere (lines 17-19 of column 8).

Art Unit: 2879

Regarding claim 40, Sekhar et al. disclose that the heat source is selected from the group consisting of a conductor, induction coil, a furnace, inert gas plasma and a laser (lines 2-11 of column 4).

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss and Sekhar et al. as applied to claim 30 above, and further in view of Miyoshi et al. (US 4613301).

Regarding claim 41, combined structure of Weiss and Sekhar et al. disclose a conductor for a heat source but does not mention a coiled tantalum wire as the heater, however, Miyoshi et al. disclose that tantalum coils are suitable as ignition heater coil (lines 67 of column 3-line 2 of column 4). Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to use coiled tantalum as a heat source in the device of Sekhar et al. for its suitability as a heating coil as disclosed by Miyoshi et al.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss and Sekhar et al. as applied to claim 30 above, and further in view of Hull et al. (US 5269810).

Regarding claim 32, combined structure of Weiss and Sekhar et al. disclose all the limitations of claim 32 except for the limitation of attachment of foil by crimping a portion of the foil around the lead.

Weiss simply discloses that the leads are attached to the foil but does not disclose the method of attaching.

However, Hull et al. disclose that crimping of the metal foil against the lead is a convention method of attaching (lines 66 of column 4-lines 2 of column 5).

Thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of crimping since this is old and conventional.

Allowable Subject Matter

Claims 15-16, 18, 25, 37-38 & 48-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 15, 16, & 48-51, the prior art of record neither shows nor suggests a method including all the claimed limitations of above claims, particularly the limitation of foil is withdrawn from the bath at a rate of about 1mm/sec to about 100 mm/sec.

Regarding claim 18, prior art of record neither shows nor suggests a combination of limitations set forth in claim 18, particularly comprising the limitation of applying a voltage to the metallic foil concurrent with immersion and withdrawal of at least a portion of the foil in the bath.

Regarding claims 25, 37, 38, prior art of record neither shows nor suggests a method including all the limitations of claims 25, 37, 38, particularly the limitation of predetermined time is about one-half second.

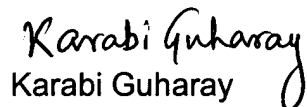
Art Unit: 2879

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karabi Guharay whose telephone number is (571) 272-2452. The examiner can normally be reached on Monday-Friday 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimeshkumar D. Patel can be reached on (571) 272-2457. The fax phone number for the organization is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karabi Guharay
Patent Examiner
Art Unit 2879